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EXAMINER	
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ART UNIT	PAPER NUMBER
3714	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/613,564	BERMAN, DENNIS R.	
	Examiner	Art Unit	
	Nikolai A. Gishnock	3714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *29 August 2007*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *39-52* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *39-52* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *02 July 2003* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *8/29/2007*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

In response to Applicant's remarks filed 8/29/2007, claims 1-38 are cancelled. Claims 39-52 are pending.

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 8/29/2007 has been entered.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 41-44 & 47-50 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the

claimed invention. It is unclear where there is support in the disclosure for the limitations, "determining if the last character of the n additional characters received is equal to the first character of the second keyword", of claims 41 & 47, "determining if the last character of the n + m - 1 additional characters received is equal to the last character of the second keyword", of claims 42 & 48, and presenting an interactive button on the display, "if and only if the last character of the n + m – 1 additional characters received is equal to the last character of the second keyword", of claims 43, 44, 49, & 50. Applicant is obliged to point out a clear recitation of support for claims 41-44 & 47-50 in paragraphs 0019-0021 and Figure 3 of the specification, as alleged. This is a new matter rejection.

5. Claims 39 & 45 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 39, in lines 22-23, and claim 45, in lines 21-22, recite the limitation displaying, "the first received character in the blank location for displaying the first character of the keyword". It is unclear whether the blank location for displaying the first character to which the claim refers is of the first or the second keyword.

6. Claims 49 & 50 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 49 & 50 recite the limitation, "the last character of the n + m - 1 additional characters", and, "the last character of the second keyword", in lines 1-2. There is insufficient antecedent basis for this limitation in independent claim 45.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

8. The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

9. Claims 39-42, 45-48, 51, & 52 rejected under 35 U.S.C. 103(a) as being unpatentable over Boon (US 6,022,221), hereinafter known as Boon, in view of New, III (US 6,155,834), hereinafter known as New III.

10. Boon teaches a method for training a learner to memorize the answer to a factual question (learning the second and third participles of English verbs, 12:32-46; the question of a question/answer pair is the verb "to beat" in its first form, "beat", 12:32-46, also in Figure 15, Item 26 & Figure 16, Item 36; "bear", along with its passive meaning, Figure 17, Item 42; "beseech", Figure 18, Item 47), the answer to the factual question including a first keyword having n characters, where n is greater than 1 (the expected response, the keyword "beat", Figure 15, Item 27; see also 12:32-46), the answer to the factual question also including a second keyword having m characters, where m is greater than 1 (the expected response, the keyword "beaten", Figure 15, Item 27; see also 12:32-46), the method performed by a computer system having a processor, a memory, a keyboard, and a display (workstation, such as a

personal computer, 6:28-30, see also Figure 1; personal computer implicitly has a keyboard and display as pictured, and inherently has a processor and memory), the method comprising: simultaneously presenting on the display utilizing a graphical user interface, (a) the factual question, (b) the answer to the factual question, (c) n blank locations for displaying the n characters of the first keyword, and (d) m blank locations for displaying the m characters of the second keyword (Figure 15 contains a display screen showing display of a q/a pair in EASY display mode, first two iterations for an embodiment of the present invention. In this display screen, the vocabulary database is for learning the second and third participles of English verbs. The question of a question/answer pair is the verb `to beat` in its first form, "beat". The expected response, "beat/beaten" is shown below the answer line, 12:32-46); then receiving a first received character entered into the keyboard by the learner (The user inputs a response on the answer line, which involves simply copying the answer for the first two of the three consecutive iterations in EASY mode, 12:32-46; The third consecutive iteration in the EASY display mode resembles the LEARN display mode, as the answer is not provided and the user must try to remember what was just shown. Only the question and the answer line is shown, ready for the user's input, 12:47-53); if the first received character is not equal to the first character of the first keyword, then presenting on the display, simultaneously with (a) the factual question, (b) the answer to the factual question, (c) at least n - 1 of the n blank locations for displaying the n characters of the first keyword, and (d) the m blank locations for displaying the m characters of the second keyword, using the graphical user interface, a first indication (Figure 8 presents the process for an incorrect response for an embodiment of the present invention. The incorrect answer is displayed above the response line with the error clearly marked, 10:40-51; See also Figure 18, which shows the screen after the user has responded incorrectly; the first indication is understood to be a carat symbol pointing to the error, 12:61-13:5); and if the first received

character is equal to the first character of the first keyword, then presenting on the display, simultaneously with (a) the factual question, (b) the answer to the factual question, (c) at least n - 1 of the n blank locations for displaying the n characters of the first keyword, and (d) the m blank locations for displaying the m characters of the second keyword, using the graphical user interface, the first received character in the blank location for displaying the first character of the keyword (the system displays on the response line the correct part of the response and left-truncates the expected answer to include only the part remaining that has not been correctly entered yet. The cursor is positioned at the next required character. The user needn't re-enter the correct part of the answer, but starts entering at the incorrect part, 10:17-32) [Claims 39 & 45].

11. What Boon fails to teach is, before receiving any other character via the keyboard, determining if the first received character is equal to the first character of the first keyword [Claim 39 & 45]. However, New III teaches a computer-implemented method for teaching a student to read, including determining the equality of the received character to the keyword of an answer (Step 920, "Correct Letter", follows a yes response to step 910 {which decides if the student's response time is satisfactory}. Step {920} is a decision point, which poses the question: "Is the letter just typed the correct letter to substitute for the next, left-most blank"? If yes, step 930 is performed. If no, step 940 is performed, 17:21-25). The method of Boon to train a learner to memorize the answer to a factual question would be implemented using the character-by-character analysis of New III to determine a score for the response, based on the timeliness and accuracy of the student's input of individual letters, rather than the correctness of the entire response. Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to determine if the first received character is equal to the first character of the first keyword before receiving any other character via the keyboard, as taught

by New III, in the method of training a learner to memorize the answer to a question of Boon, in order to test whether the student has performed satisfactorily by determining the percent of correct responses to missing letters for the last word [Claims 39 & 45].

12. What Boon further fails to teach is receiving a second received character entered into the keyboard by the learner; then before receiving any other character via the keyboard, determining if the second received character is equal to the first character of the first keyword; if the second received character is not equal to the first character of the first keyword, then presenting on the display, using the graphical user interface, the first indication; and if the second received character is equal to the first character of the first keyword, then presenting on the display, using the graphical user interface, the second received character in the blank location for displaying the first character of the first keyword [Claims 40 & 46], receiving n additional characters entered into the keyboard by the learner; then before receiving any other character via the keyboard, determining if the last character of the n additional characters received is equal to the first character of the second keyword; if the last character of the n additional characters received is not equal to the first character of the second keyword, then presenting on the display, using the graphical user interface, the first indication; and if the last character of the n additional characters received is equal to the first character of the second keyword, then presenting on the display, using the graphical user interface, the last character of the n additional characters received in the blank location for displaying the first character of the second keyword [Claims 41 & 47], and receiving n + m - 1 additional characters entered into the keyboard by the learner; then before receiving any other character via the keyboard, determining if the last character of the n + m - 1 additional characters received is equal to the last character of the second keyword; if the last character of the n + m - 1 additional characters received is not equal to the last character of the second keyword, then presenting on the

display, using the graphical user interface, the first indication; and if the last character of the n + m - 1 additional characters received is equal to the last character of the second keyword, then presenting on the display, using the graphical user interface, the last character of the n + m - 1 additional characters received in the blank location for displaying the last character of the second keyword [Claims 42 & 48]. However, New III teaches a cycle of repeatedly matching a user's input with characters in answer keywords, one by one, until the entire list of keywords is finished. As demonstrated in Figure 6(a), process loops between steps 890-960, during which, characters are repeatedly received (between steps 900 & 910), determined to either be equal or not equal to a character in a target word (Step 920, Correct Letter?), if the received character is equal to the character in the target word, presenting the correct letter {same as the received letter} at the blank position (Step 930, Substitute Correct Letter for Blank), and, if unequal, displaying a first indication (Step 950, Show Correct Word in Red, and Step 960, Substitute * for Blank). The processing loop of New III shown in Figure 6(a) would be valid for a first, second, n, or n + m –1 received characters as necessary. The processing loop of New III shown in Figure 6(a) would further be equally valid for all characters of all the keywords, because the loop is repeated for each character and restarted for each new word (15:35-18:49). The processing loop of New III would allow the method of Boon to train a learner to memorize an answer, to check each character for equality with a character in a plurality of keyword answers, before receiving any other characters. Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to have used the process of New III to receive a second received character, n additional characters, or n + m – 1 additional characters entered into the keyboard by the learner; then before receiving any other characters via the keyboard, determining if the second, n, or n + m – 1 additional received characters are equal to a character of one of the plurality of keywords; if the second, n, or n + m – 1 additional received

characters are not equal to the first character of the first keyword, then presenting on the display, using the graphical user interface, the first indication; and if the second, n, or n + m – 1 additional received characters are equal to a character of one of the plurality of keywords, then presenting on the display; using the graphical user interface, the second, n, or n + m – 1 additional received characters in the blank location for displaying the character, in the method of Boon to train a learner to memorize an answer, in order to test whether the student has performed satisfactorily by determining the percent of correct responses to missing letters for the last word [Claims 40-42 & 46-48].

13. Boon teaches receiving a request from the learner to present a hint on the display; and then presenting on the display, using the graphical user interface, the first character of the first or second keyword in the blank location for displaying the first character of the respective first or second keyword (A hint is prepared and displayed. If the user specifically requests a hint by pressing the less than (<) or <F2> key, the next letter of the answer is displayed on the response line, the same as if the user keyed an incorrect character. If the user presses the greater than (>) or <F3> key, the next word of the answer is displayed on the response line. An incorrect answer as well as a response of <Enter> with no additional input from the user are each interpreted as a request for the next letter of the answer. A hint request causes the remaining answer to be truncated the same as an incorrect guess, 10:17-32) [Claims 51 & 52].

14. Claims 43, 44, 49, & 50 are rejected under 35 U.S.C. 103(a) as being unpatentable over Boon, in view of New III, as applied to claims 39, 42, & 45 above, and further in view of Fujino et al. (US 6,755,662 B2), hereinafter known as Fujino.

15. Boon and New II teach all the features of claims 39, 42, & 45, as demonstrated above. New III teaches checking if and only if the last character of the n + m - 1 additional characters

received is equal to the last character of the second keyword (See claims 40-42 & 46-48). What Boon and New III fail to teach is presenting an interactive button on the display, using the graphical user interface [Claims 43 & 49], and where the selection of the interactive button causes the computer system to present another question on the display [Claims 44 & 50]. However, Fujino teaches a screen (Figure 20) that is displayed after the student's input is received (When the student controlling section receives the FAQ question that the student selected, the answer corresponding to the question is retrieved from the FAQ-DB 32 and transmitted to the student with the screen for displaying answers (S42), 10:17-21). The screen presents interactive "continue" buttons using a graphical user interface (In the FAQ answer screen, the question that the student selected and the answer corresponding to the question is displayed. Further, buttons of "Effective, Continue search", "Effective, End search", "Ineffective, Continue search" and "Ineffective, End search" are displayed at the lower part of the screen, 10:22-45) that present another question to the student (In the step S46, it is judged whether the button is the "End search" button or not. If it is the complete search button, the process ends, but if it is not, the process returns to the step S40 and transmits the FAQ question again to the student, 10:50-54). The interactive continue button of Fujino would be displayed in the method of learning of Boon, if and only if the process loop of New III detected that the last character received is equal to the last character of the second keyword of the answer. The interactive button of Fujino would further cause the method of learning of Boon to restart the loop, drawing another question. Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to have presented the interactive button of Fujino, where the selection of the interactive button causes the computer system to present another question on the display, on the display of Boon, using the graphical user interface, if and only if the last character of the n + m - 1 additional characters received is equal to the last character of the

second keyword, as in New III, in order for the method to judge whether presentation of the question and answer was effective or ineffective at training the student at heis/her level and the question level [Claims 43, 44, 49, & 50].I

Response to Arguments

16. Applicant's arguments filed 8/29/2007 have been fully considered but they are not persuasive. See below.

17. In response to the Applicant's assertion that the Examiner and the Applicant agreed that New III does not disclose locations for each character in a keyword, see page 9, third paragraph, the Examiner does not recall making this statement. New III clearly discloses displaying stars and letters to indicate the locations of blanks for each character in a word, at 17:9-60. Further, the potential limitations, see page 9, paragraph 4, discussed in the interview of 8/28/2007, including, " the first indication not changing the character displayed in the location for receiving the first character of the keyword displayed", the insertion of both the text of a keyword and a non-keyword into the answer, and distinguishing an answer requiring the correct substance of the answer as well as its spelling, are not recited in the rejected claims. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

18. In response to the Applicant's statement that neither Boon nor New III discloses the features of claim 39 (or 45), see page 10, paragraph 3, Boon teaches displaying a question/answer pair and blank locations for displaying first and second keywords, in at least Figures 15-18. Boon further teaches where the question is a factual question, such as the English verb, "to beat" in its first form (AKA present tense), where the expected response is the second and third participles (AKA the past and past participle tenses), "beat/beaten" (12:32-46).

19. Applicant's further arguments, see pages 11 & 12, demonstrating support for the claim limitation, "the answer to the question including a keyword having n characters, where n is greater than 2", are moot in view of the cancellation of claims 1-38. However, the Examiner maintains that clear support for this limitation is not found in the disclosure, as originally filed and in sufficient detail, such that one skilled in the art can reasonably conclude that the Applicant had possession of the claimed invention. See MPEP 2163. In this case, the limitation is construed to be new matter, because one skilled in the art could not deduce that an answer keyword *must* have "greater than 2" characters, merely by noting that the Applicant's example keyword "Dallas" happens to have 6 letters. The limitations of the instant claims, "determining if the last character of the n additional characters received is equal to the first character of the second keyword", of claims 41 & 47, "determining if the last character of the n + m - 1 additional characters received is equal to the last character of the second keyword", of claims 42 & 48, and presenting an interactive button on the display, "if and only if the last character of the n + m – 1 additional characters received is equal to the last character of the second keyword", of claims 43, 44, 49, & 50, also appear to suffer from this deficiency, because a person skilled in the art would not have recognized these limitations in the disclosure as originally filed.

20. New III, at 16:50-51, additionally demonstrates that it is old and well known to use a keyword having 3 or more characters, because there are very few English words having only one or two characters, this dearth of words limiting their utility as keywords, which are significant or memorable words. Thus, the argument is not persuasive.

Conclusion

21. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Memorize-It for Macintosh and Windows (versions 3.0 and 4.0) disclose a computer

system for generating flash cards, otherwise known as tachistoscopic learning, and a method for quizzing a user, having a Type-In format for answering. Memorize-It 4.0 discloses that the Type-In mode displays a one or two word answer to a given question, where the answer must be typed exactly as it appears in order to be scored correctly. Memorize-It 4.0 also discloses a user choosing to look at a hint while looking at the front of the card.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nikolai A. Gishnock whose telephone number is 571-272-1420. The examiner can normally be reached on M-F 8:30a-5p.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Xuan M. Thai can be reached on 571-272-7147. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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11/14/2007

Ronald Laneau
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11/17/07